

### **REMARKS**

Applicant has carefully reviewed and considered the Office Action mailed on December 12, 2003, and the references cited therewith.

No claims are amended, canceled, or added; as a result, claims 1-23 remain pending in this application. Applicant notes that claims 1, 7, 8 and 13 now properly include the term "wireless" to describe the transceiver recited in each of the independent claims. The term "wireless" was added by amendment in the response filed February 19, 2003, but erroneously omitted from the claims provided in the response filed July 7, 2003. Applicant apologizes for any inconvenience caused by the omission.

### **Response to Amendment & Declaration**

The declaration filed on October 10, 2003 was stated to be insufficient to establish a conception of the invention prior to the effective date of Ruckdashel (U.S. 6,038,542).

The evidence submitted was stated to be insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Ruckdashel reference. Additionally, the evidence submitted was stated to be insufficient to establish a conception of the invention prior to the effective date of the Ruckdashel reference. Applicant respectfully traverses the Office Action's statement that the declaration is insufficient to establish conception of the invention prior to the effective date of Ruckdashel.

In order to swear behind a reference, 37 C.F.R. 1.131 provides that an applicant may provide a declaration providing a showing of facts, stating:

"The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application."

Applicant's declaration filed October 10, 2003 provided a showing of facts sufficient to show conception of the invention followed by due diligence until the filing of a patent application (constructive reduction to practice).

The Office Action stated "the evidence that has been submitted does not show a complete disclosure to another and as well does not show that the requisite means and their interaction is

comprehended.” Applicant respectfully disagrees with this statement. The evidence provided in Exhibit A clearly shows a complete disclosure to another. Exhibit A is a signed invention disclosure form that was signed by two witnesses, each of whom stated that they understood the disclosure. Additionally, Exhibit A provides requisite means and interaction that is consistent with the claimed invention. For example, Exhibit A discloses a computer having an integral paging transmitter (e.g. notification controller connected to the bus of the computer and the notification transmitter), and a paging receiver (e.g. the portable transceiver). Thus conception of each of the requisite elements of the claimed invention and their interaction is clearly shown in Exhibit A.

Further evidence of a complete disclosure to another is provided in Exhibit B. Exhibit B is a letter from a search agent providing the results of a patent novelty search. The letter indicates that details regarding the invention were disclosed to another (i.e. the search agent). The disclosure to the agent of the requisite means and their interaction was sufficiently complete such that the agent was able to perform the novelty search.

For all of the above reasons, Applicant respectfully submits that the declaration filed October 10, 2003 was sufficient to swear behind Ruckdashel.

Although Applicant believes that Ruckdashel cannot properly be applied against Applicant’s claimed invention, Applicant believes the claimed invention can be distinguished from the cited references as argued below.

### §103 Rejection of the Claims

Claims 1-23 were rejected under 35 USC § 103(a) as being unpatentable over Tabuchi (U.S. 5,822,583) in view of Ruckdashel. In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947

F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully traverses the rejection and submits that the Office Action does not provide a proper motivation to combine Tabuchi and Ruckdashel. Applicant further submits that the combination of Tabuchi and Ruckdashel fails to teach or disclose each and every element of Applicant's claims.

For example, each of independent claims 1, 7, 8 and 13 recites a wireless transceiver. Applicant notes that the Merriam Webster online dictionary at [www.m-w.com](http://www.m-w.com) defines a transceiver as "a radio transmitter-receiver that uses many of the same components for both transmission and reception." Applicant submits that this definition is consistent with the use of the term by those of skill in the art. Applicant has reviewed Tabuchi and Ruckdashel and can find no teaching or disclosure of a wireless transceiver integrated within a computer to transmit signals to a corresponding receiving transceiver. The Office Action states that Tabuchi at column 1, lines 28-32 teaches a transceiver. Applicant respectfully submits that the cited section of Tabuchi does not teach a wireless transceiver. The cited section of Tabuchi merely states that generated event data is stored in a queue for delivery to application programs. There is no teaching or disclosure of any involvement of a wireless transceiver, rather the event data is stored in queues on storage devices.

In addition, Ruckdashel fails to teach or disclose a wireless transceiver as recited in Applicant's claims 1, 7, 8 and 13. The Office Action states that Ruckdashel at column 3, lines 26-32 "teaches notification as being in the form of a message which must be communicated as a signal of some form." Applicant notes that the cited section merely refers to email message delivery, not the delivery of a message via a wireless transceiver integrated with a computer system. Furthermore, the Office Action asserts that element 104 in Ruckdashel is a transceiver. Ruckdashel, at column 2, lines 60-66 makes clear that element 104 is an input/output module that includes circuitry for interfacing the processor 102 with other devices within the computer system 100, including the display or output device 106, and the (optional) local mass storage 108. The module 104 also interfaces the computer 100 to the network 120 which may be a local or wide area network. Thus element 104 is not in fact a wireless transceiver as recited in Applicant's claims.

For the above reasons, Applicant respectfully submits that the combination of Tabuchi and Ruckdashel fails to teach or disclose a wireless transceiver and therefore fails to teach each

and every element of Applicant's claims 1, 7, 8 and 13. Applicant respectfully requests that the Examiner identify a specific element of Tabuchi or Ruckdashel that corresponds to the wireless transceiver of Applicant's claims. Additionally, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 7, 8 and 13.

Claims 2-6 and 19 depend from claim 1, claims 20-22 depend from claim 7, claims 9-12 and 23 depend from claim 8 and claims 14-18 depend from claim 13. These dependent claims inherit the elements of their respective base claims and add further patentable distinctions. They are therefore nonobvious for the same reasons as discussed above regarding claims 1, 7, 8 and 13.

Additionally, no proper motivation to combine the references has been cited. The Office Action must show a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings (see MPEP 2143.01). The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Mere conclusory statements do not fulfill the Office Action's burden. *Id.* The court in *Lee* also stated that "This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. With respect to the motivation to combine Tabuchi and Ruckdashel, Applicant respectfully submits that the Office Action has not provided such evidence or explanation for a suggestion or motivation to combine. Instead, the Office Action merely makes the conclusory statement that the combination of Tabuchi with Ruckdashel was obvious to one of ordinary skill in the art at the time the invention was made "so as to have achieved more flexibility, quicker access, and a more efficient system." Applicant respectfully submits that the Office Action has not provided objective evidence and authority for a suggestion or motivation to combine the references. The Office Action merely provides a conclusory statement of the Examiner's subjective judgment of the purported benefits of the combination, and does not provide objective reasoning as to how one of skill in the art would be motivated to combine the art. Applicant respectfully requests that the Examiner provide a motivation to combine that

meets the standards set forth by the Federal Circuit in *Lee* or withdraw the rejection of claims 1-23.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

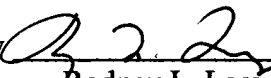
Respectfully submitted,

LARRY A. NICKUM

By his Representatives,

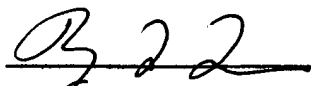
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Date June 14, 2004

By   
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-145, on this 14<sup>th</sup> day of June, 2004 (Monday).

Rodney L. Lacy  
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Signature